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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/180,432 02/12/99 MACHINO

F 981361

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IM22/0331

EXAMINER

RUDDOCK, U

ART UNIT	PAPER NUMBER
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1771

DATE MAILED:

03/31/00

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

*Stays in Case*

<b>Office Action Summary</b>	Application No. <b>09/180,432</b>	Applicant(s) <b>Machino et al.</b>
	Examiner <b>Ula C. Ruddock</b>	Group Art Unit <b>1771</b>

Responsive to communication(s) filed on Feb 12, 1999.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-54 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-54 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 10, and 45, the phrase "wool-like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "wool-like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Regarding claims 2 and 45, it is unclear what is being claimed by Applicant. Is Applicant claiming the insulation material only or the combination of a pair of electrodes with insulation material? These claims are being treated as if the insulation material is what is being claimed, because of the preamble.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by McCullough, Jr. et al. (US 4,997,716). McCullough, Jr. et al. teach a fire retarding and fire shielding structural panel for a vehicle, comprising at a composite composed of a thermosetting resin matrix containing a multiplicity of non-flammable carbonaceous fibers (abstract). Thermosetting resin include phenolic resins and melamine resins (col 3, ln 6-9). The length of the individual fibers are in the range of 0.5 to 20 mm and the diameter of the carbon fibers of the invention range from 2 to 25 microns (col 4, ln 20-28).

***Claim Rejections - 35 USC § 102/103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-54 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McCullough, Jr. et al., (US 4,997,716), as set forth above. Inherently, a composite with the structure shown by McCullough, Jr. et al. would have the same tensile strength, bulk density, compression recovery, and thermal conductivity as claimed in Applicant's invention. In addition, the presently claimed properties of tensile strength, bulk density, compression recovery, and thermal conductivity would have been present once the

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McCullough, Jr. et al. product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection made above under 35 USC 102.

Also, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ula C. Ruddock whose telephone number is (703) 305-0066. The Examiner can normally be reached Monday through Thursday from 6:30 AM to 4 PM and on alternate Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor Terrel Morris can be reached at (703) 308-2414.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-2351.

Ula C. Ruddock *ULC*  
Patent Examiner  
Art Unit 1771  
March 27, 2000

*BLAINE COPENHEAVER*  
BLAINE COPENHEAVER  
PRIMARY EXAMINER